PRELIMINARY REMARKS ACCOMPANYING REQUEST FOR CONTINUED EXAMINATION
Serial No. 09/002,906
Filed: 01/05/1998

REMARKS

Claims 1 through 12 and 19 through 29 remain in the application, and claims 12 through 18 have previously been cancelled.

Claims 19, 23 through 25, 28 and 29 have been rejected under 35 U.S.C. 102(e) as being anticipated by Schein (US Patent No. 6,323,911, hereinafter referred to as "Schein '911"). Claims 1 through 12 and 22 have also been rejected by 35 U.S.C. 103(a) as being unpatentable over the Schein '911 patent in view of Kostreski et al (US Patent No. 5,734,589, hereinafter referred to as "Kostreski"). Further, claims 20, 21, 26 and 27 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Schein '911 patent in view of Schein (US Patent No. 6,002,394, hereinafter referred to as "Schein '394"). These rejections are respectfully traversed.

Claim 1 requires, in part, "one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to the user specified theme". Claim 8 requires "one or more favorite channel lists, the favorite channel lists comprising one or more logical channels relating to a user specified theme". Claim 19 requires "identifying one or more channels showing an event of a user specified theme, wherein the step of identifying is achieved by matching one or more event themes from an electronic program guide (EPG) content database to the user-specified theme" and "automatically adding each one of the channels to a favorite channel list, wherein such adding does not require user intervention".

In part, it was asserted in the Advisory Action that:

The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Claim 19, Applicant argues the difference between Schein's Fig. 6D and Applicant's "favorite channel list". In response, the Examiner respectfully disagrees with Applicant's remark because it seems that Applicant confuses and contradicts himself regarding the difference between "favorite program list" and "favorite channel list". Accordingly, Schein clearly discloses a "favorite channel list" in Fig. 6D because Schein's Fig. 6D shows elemen "Favorite and reminder" with sub-element "Display favorite only" along with a

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list of favorite channels along with its associates-TV programs. Thus, Schein's Fig. 6D meets and encompasses Applicant's limitation "favorite channel list".

However, it is again pointed out that the Schein '911 disclosure clearly distinguishes between "favorite channels" and "favorite programs", and the showing in Figure 6D of Schein '911 clearly illustrates this distinction. As noted in the Office Action and the Advisory Action, Figure 6D of Schein '911 shows a screenshot labeled "FAVORITES AND REMINDERS". It is contended in the Advisory Action that "it seems that Applicant confuses and contradicst himself regarding the difference between 'favorite program list' and 'favorite channel list'". There is no clarification as to what part of the Applicant's arguments are believed to be contradictory. However, it is noted that the items listed in Figure 6D of Schein '911 are explicitly identified as "PROGRAM"'s. Simply because the listing includes the channel corresponding to each of the "PROGRAM"'s that are listed, does not make the list in Figure 6D a "favorite channel list", particularly a "favorite channel list[] comprising one or more logical channels relating to the user specified theme". Yet another factor indicating to one of ordinary skill in the art that this is a listing of programs, and not a "favorite channel list", is the fact that the listing of channels includes duplicates of at least one channel ("PBS" occurs three times in the listing), which clearly suggests that this is not a listing of the user's favorite channels, but simply a listing of the channels that correspond to each of the listed programs. (In other words, if this was truly a listing of "favorite channels", why is one channel listed three times when being listed one time would clearly be sufficient in a "favorite channel listing"?) It is therefore submitted that one of ordinary skill in the art, considering the showing in Figure 6D of Schein '911, would understand that the listing in Figure 6D is keyed to the identities of the programs, and not the channels.

Further, it is noted that Figure 10D contains a screenshot that is also titled "FAVORITES AND REMINDERS", and a listing of "PROGRAM"'s is shown, with a listing of corresponding "TIME"'s for each of the listed programs. Also, Figure 6A of Schein '911 shows a listing of channels, but clearly these channels are not any favorites, as the channels listed are simply a sequential listing of the channels available, and not any selected channels.

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This is also true for Figures 6B, 6C, 7A, 7B, 7C, 7D, and 8A. Further, Figure 8B lists as one of its options, "(4) PUT THIS *PROGRAM* ON MY FAVORITES LIST" (emphasis added) and Figure 9D lists as one of its options "(4) REMOVE THIS *PROGRAM* FROM FAVORITES LIST..." (emphasis added). It is therefore again submitted that one of ordinary skill in the art, considering this portion of the disclosure of Schein '911, could only be led to the conclusion that Schein '911 is describing a listing of programs, and not "a favorite channel listing".

Turning to the descriptive text of the Schein '911 patent, it is submitted that the description therein would clearly lead one of ordinary skill in the art to believe that the listing of programs in the Schein '911 system is not the same as any listing of channels, specifically a listing of "favorite channel lists comprising one or more logical channels relating to the user specified theme". In particular, Schein '911 states at col. 12, lines 12 through 26 (emphasis added):

> Within the database, each program is associated with a variety of criteria or features, such as particular actors, actresses, directors, the type of movie (e.g., action, comedy) and the like. When the viewer selects a program as a favorite, for example, he or she will have the option of designating the criteria or reason(s) that the program is a favorite (i.e., actor, director, etc.). The computer will include a processor and suitable software for automatically searching the database for other programs having the same criteria. The processor will automatically place the programs that include the designated criteria into the selection window and provide visual indication of each program in the matrix of cells in the program guide. In this way, the program guide will automatically customize itself to the individual viewer to facilitate use of the television schedule.

This appears to be nothing more than just a search for programs that might be similar to a selected favorite program. It has nothing to do with creating and managing a favorite channel list. It is therefore submitted that one of ordinary skill in the art, considering this portion of the Schein '911 disclosure, would understand that the Schein '911 system deals with *programs*, and not *channels*. Still further, Schein '911 indicates at col. 12, lines 27 through 47, that (emphasis added):

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FIGS. 9A-9F illustrate a method for designating a program as a favorite. For example, an Item InfoMenu 130 is opened and the viewer scrolls down to section (4), and selects "Put this program on my favorite list" by clicking cylinder 24. A Favorites submenu automatically appears with a panel asking the viewer why this program has been shown as a favorite. For example, FIG. 9B illustrates a Favorites submenu 155 for a sitcom or program and FIG. 9C illustrates a submenu 156 for a movie. Other types of programs will have other unique submenus. The viewer is given a choice to scroll down to choose reasons for selecting the program as a favorite, such as performers, categories, series as a whole, etc. This feature could also be utilized to allow the viewer to go to the database of his or her preferences. It would then be possible to link to other programs with matching criteria, thereby allowing the viewer to customize the system to his or her needs. For example, if the viewer selects "performers" (see FIG. 9C), this would bring up a listing of known performers (or a similar appropriate listing) in this program. The viewer than identifies which ones are favorites.

Again, nothing in this portion of the Schein '911 patent gives one of ordinary skill in the art any indication that there is any creation of a "favorite channel list" in the Schein '911 system, and clearly the Schein '911 patent would be more likely to lead one of ordinary skill in the art to believe that it is more important and significant to create a listing of favorite *programs*, rather than any listing of favorite channels.

As noted previously with respect to the Schein '911 patent, and also the Schein '911 patent, the positions taken in this Office Action and previous Office Actions in this patent application, channel and program appear to be deemed as the same thing. Clearly they are not the same thing. A channel has multiple temporally arranged programs. A program is a single program with an associated channel. There is no way to effectively surf channels via a list of programs because the programs might not be on at the same time. Selection of a program does not necessarily cause current selection of a channel because the program may not be available at the time it is selected. However, one can move easily from channel to channel in a list of favorite channels. Thus, they are fundamentally different things, and cannot be equated as the Examiner appears to be doing.

Turning to the Kostreski et al. patent, which has been relied upon (in combination with the Schein patent) in the rejection of claims 1 through 12, its disclosure is cited as teaching

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mapping favorite channel lists to corresponding logical or virtual channels. This assertion is respectfully traversed. While some aspects of mapping appear, there is no mention of any type of favorite channel found in Kostreski et al. Even if there were, Kostreski et al. still lacks the teaching indicated above as missing from Schein '911. Thus neither Schein '394 nor Kostreski nor their combination teach each and every element of Applicant's claims 1, 8, 19, 24 and 25. Applicant respectfully requests the withdrawal of the rejection of claims 1, 8, 19, 24 and 25 as well as the claims that depend therefrom.

With respect to the Schein '394 patent, the system that is disclosed therein has been discussed at length previously, and particularly with respect to the issue of the description of favorite *programs*, in contrast to favorite *channels*. Therefore, it is submitted that the disclosure of the Schein '394 patent cannot make up for the basic omission in the Schein '911 patent discussed above. For the sake of completeness, it is again noted that Schein '394 does not identify "channels". Schein '394 appears to identify programs, not channels, such as at col. 16, lines 25 through 35 (emphasis added):

> When the viewer selects a program as a favorite, for example, he or she will have the option of designating the criteria or reasons(s) that the program is a favorite (i.e., actor, director, etc.). The computer will include a processor and suitable software for automatically searching the database for other programs having the same criteria. The processor will automatically place the programs that include the designated criteria into the selection window and provide visual indication of each program in the matrix of cells in the program guide. In this way, the program guide will automatically customize itself to the individual viewer to facilitate use of the television schedule.

This appears to be nothing more than just a search for programs that might be similar to a selected favorite program. It has nothing to do with creating and managing a favorite channel list. Schein et al. clearly provides visual indications of programs, not favorite channels. The Office Action also cites Col. 10, lines 55-60 of Schein et al. as disclosing favorite channel lists. The section in Col. 10, with the heading of "FAVORITE CHANNEL LISTS" clearly sets forth that "The user interface and database engine provide screens to facilitate the ordering and selection of channels to be displayed in the guide" at lines 47-49.

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There is no teaching of any sort of automated adding of channels without user intervention as claimed. If anything, the cited language teaches away from the claimed invention, as a user interface is used and appears to directly require user interaction for selection of channels. It should be noted that this language is also consistent with the background of the invention section of the present application, where the user management of favorite channel lists was identified, as was the problem they created of having favorites lists "only as organized as the user who created them."

For the reasons set forth above, it is submitted that the Schein '911, Kostreski, and Schein '394 patents, either alone or in the allegedly obvious combination set forth in the Office Action, could not lead one of ordinary skill in the art to the requirements of claims 1 through 12 and 19 through 29, and therefore withdrawal of the rejections of these claims is respectfully requested.

Conclusion

The pending claims are respectfully submitted to be in condition for allowance. Accordingly, notification to that effect is earnestly requested.

Respectfully submitted,

Gateway, Inc.

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Jeffrey A. Proehl
Reg. No. 35,987
Gateway, Inc.
610 Gateway Drive, Y-04
North Sioux City, SD 57049
Telephone (605) 232-1967
Fax   (605) 232-2612

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